

### **REMARKS**

This amendment is submitted in response to the Office Action mailed on May 18, 2005. Claims 1, 9, 33, and 34 are amended, and claims 24-28, 30, and 32 are canceled. As a result, claims 1-23, 29, 31, and 33-35 are now pending in this application. Of these, claims 1-10, 13-15, 30, and 33-34 stand rejected.

Although applicant addresses the rejections as follows, it also reserves all applicable rights not exercised in connection with this response, including, for example, the right to swear behind one or more of the cited references, the right to rebut any tacit or explicit characterization of the references, and the right to rebut any asserted motivation for combination. Applicant makes no admission regarding the prior art status of the cited references, regarding them as being only of record.

### **Unacknowledged Information Disclosure Statement**

Applicant submitted Information Disclosure Statements and associated 1449 Forms on December 14, 2001 and March 18, 2004. However, applicant has not received any indication that the Statements have been considered.

Accordingly, applicant requests respectfully that initialed copies of the applicable 1449 Forms be returned to its representatives to indicate consideration of the cited references.

### **Response to §101 Rejection**

Claims 1-10, 14-15, 24-28, 30, and 32-34 were rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.

In response, applicant has amended several claims, namely claims 1, 9, 33, and 34, to reference a computer-implemented method. Claims 24-28 have been canceled.

Regarding claims 14 and 15 applicant respectfully submits that these claims are directed to a system comprising various means elements. As such, applicant believes that the claims clearly pertain to an apparatus. The substance of dependent claim 15 does not alter the fact that the claims recite an apparatus.

Accordingly, applicant requests respectfully that the Examiner reconsider and withdraw the §101 rejections.

### **Response to §112 Rejections**

Claims 24, and 26-28 were rejected under 35 U.S.C. § 112, second paragraph, for indefiniteness. In response, applicant submits that this rejection is rendered moot by the cancellation of these claims.

### **Response to §102 Rejections**

Claims 24-26 and 32-34 were rejected under 35 U.S.C. § 102(e) for anticipation by Wanderski (U.S. 6,519,617). In response, applicant respectfully submits that Wanderski does not meet all the requirements of claims 33 and 34.

For example, Wanderski does not teach the combination from claim 33 of “providing a set of two or more DTDs” and “selecting at least one of the set of DTDs.” And regarding claim 34, Wanderski does not teach partial disambiguation.

The Office Action alleged that

Wanderski discloses transformation (using software) for converting an XML document with DTD into a new transformed document reflective of an XML dialect (Wanderski column 4 lines 25-42). A plurality of DTDs are generated, as needed, so that a document (an output file) will conform to its new DTD accordingly (Wanderski column 11, lines 60-67). In this fashion, various documents are “disambiguated” via compliance with their respective (different) DTDs, changing all, or portions of documents as necessary.

However, it does not appear that one of skill in the art would regard the cited passages as meeting all the requirements of claims 33 and 34. Indeed, as best understood, it appears that the cited passages indicate that Wanderski merely accepts a document as input and dynamically generates a DTD, rather than selecting a DTD from a set of DTDs or performing any partial disambiguation.

Accordingly, applicant requests respectfully that the Examiner reconsider and withdraw the §102 rejections based on Wanderski.

### **Response to §103 Rejections**

The Office Action rejected claims 1-10, 13-15, 27-28, and 30 were rejected under 35 U.S.C. §103(a) as unpatentable over Wanderski. In particular, the Office Action admitted (at page 6) that

Wanderski does not specifically teach selection based upon 'scoring' of candidate paths[, but argues that it] teaches redundancy reduction and default attribute values comprising reducing redundant nodes of a DOM tree, as well as keeping count of the number of times a value occurs, so as to determine a 'default' value (Wanderski column 13 lines 44-53, column 14 lines 4-11). Since these methods of DOM alteration incorporate a form of tallying for statistical purposes, it would have been obvious ... to keep score of the nodes (as explained above) so as to provide the benefit of streamlining the DOM tree for a more compact document.

However, applicant respectfully submits that the Action appears to be applying the wrong standard of obviousness. The issue is not whether there is a form of statistical tallying that could be made to look like the required scoring: The issue is whether one of skill without hindsight would have recognized the desirability of modifying Wanderski to include this scoring.

On that issue, the Office Action falls short of establishing a prima facie case of obviousness. First, nothing in the record has been cited to suggest that Wanderski's DOM trees aren't already compact. Second, nothing in the record has been cited to suggest that scoring would improve the compactness of Wanderski's DOM trees. In the absence of any substantiation in the record, it appears that the Examiner has tacitly taken official notice of the contents of the art. As such, applicant requests respectfully, under MPEP 2144.03 and 37 CFR §1.104(d)(2), that the Examiner submit documentary evidence, in the form of an appropriate reference or a personal affidavit, supporting his proposed motivation for combination. Absent appropriate evidentiary support, applicant requests respectfully that the Examiner reconsider and withdraw the §103 rejections.

**CONCLUSION**

In view of the amended claims and these remarks, applicant requests respectfully that the Examiner reconsider the application. Moreover, applicant invites the Examiner to telephone its patent counsel Eduardo Drake at (612) 349-9593 to resolve any issues that may delay allowance of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

MICHAEL S. ZAHARKIN

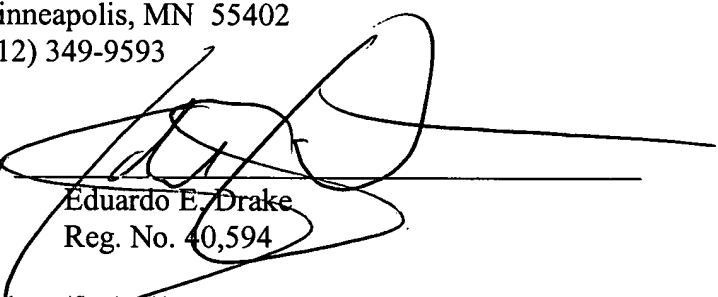
By his Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402  
(612) 349-9593

Date

18 Oct. 2005

By

  
Eduardo E. Drake  
Reg. No. 40,594

**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 18 day of October, 2005.

Name

KACIA LEE

Signature

Kacia Lee